

Application No. 10/021,407  
Office Action dated: July 10, 2003

### REMARKS/ARGUMENTS

Claims 5-6 are rejected as anticipated. Claims 5-8 are rejected as obvious. Claim 5 is amended and Claims 13 and 14 are added. No new matter is added. Claims 5-8 and 13-14 are pending.

#### 102 Rejection:

Claim 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,605,750 to Sheridan et al. With respect to Claim 5, as amended, it is respectfully urged that Sheridan et al. does not show a sharpened and closed distal tip with a cavity. Also, it is not clear how Sheridan et al. teaches material for providing an artifact spaced from the side opening.

The Examiner states that Sheridan et al. teaches "a hollow cavity (64) filled with a material (82) which will leave an artifact (Col. 6, lines 10-27)." However, Sheridan states that element 64 is an "X-ray eye". Accordingly, it is respectfully urged that Sheridan does not teach a sharp closed distal tip with a cavity. Nor is clear how Sheridan et al. teaches or suggests a side opening for receiving tissue, and material spaced longitudinally from the side opening.

#### 103 Rejection

The examiner rejects Claims 5-8 with respect to Loos et al. in view of Werne, stating:

*"Loos et al. discloses a biopsy device (Figure 8) compatible for use with a MRI machine comprising a substantially tubular needle having a distal end, a proximal end, and a longitudinal axis therebetween (Col. 6, lines 24-25), a port on the needle for receiving a tissue sample; and a sharpened distal tip attached to the distal end of the needle (Col. 6, lines 25-30). The distal tip has a hollow cavity and the hollow cavity is shown to be partially filled with a material (93) that will leave an artifact"*

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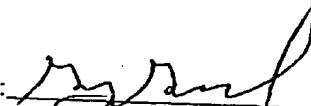
*under MRI (Figure 8; Col. 6, lines 25-33). It can be seen in the cross-section of the needle shown in Figure 8 that the material (93) is in fact located within the distal tip of the hollow needle (85). This cross-section figure of the needle shows that the phrase "hollow needle" (Col. 6, line 26) makes reference to the fact that there is no solid material forming the needle between the outer surface and the surface defining the interior lumen, not that there is an interior lumen for the thin rod (87) to pass through."*

However, it is respectfully urged that Loos et al. in Figure 8 does not show a needle having a sharp closed distal tip with a cavity. Figure 8 of Loos et al. appears to show an open ended needle.

Further, even if Loos et al. is considered to teach a closed tip, it is respectfully urged that Loos et al. does not teach or suggest a side opening in the needle for receiving tissue, where material in the sharp closed tip is spaced longitudinally from the side opening.

It is respectfully submitted that the claims, as amended distinguish over the references cited by the Examiner. Reconsideration and allowance is requested.

Respectfully submitted,

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